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Application No. : 10/631,882
Amdt. Dated : August 18, 2006
Reply To O.A. Of : May 18, 2006

BEST AVAILABLE COPY**REMARKS**

The Applicants thank the Examiner for his/her careful and thoughtful examination of the present application. By way of summary, Claims 1-21 were pending in this application. In the present amendment, the Applicants have amended Claims 1, 4, 14, and 16-20 and cancelled Claim 6 without prejudice or disclaimer. Accordingly, Claims 1-5 and 7-21 remain pending for consideration.

Response To Restriction Requirement

The Applicants thank the Examiner for contacting Applicants' representative by telephone and allowing the provisional election of Claims 1-21 (Group 1) by telephone in response to the Examiner's restriction requirement. The Applicants affirm their election without traverse to proceed with the prosecution of Claims 1-21 (Group 1) on the merits without prejudice to canceled Claims 22-27 (Groups 2 and 3). The Applicants reserve the right to pursue any non-elected claims in one or more divisional or continuation applications.

Rejection Of Claims 16-18 and 20 Under 35 U.S.C. § 112, Second Paragraph

In rejecting Claims 16-18 and 20 under 35 U.S.C. § 112, second paragraph. The specific rejections made by the Examiner, and Applicants response to these rejections, are discussed below.

Claim 20

With respect to Claim 20, the Examiner has stated that because the human body is non-statutory subject matter, the following language in Claim 20 is improper: "the plurality of opposing members removably position said silicone lenses against a patient's ear." Although the claim is correct, the claim has been clarified, without altering its scope, to recite "the plurality of opposing members is capable of removably positioning said silicone lenses against a patient's ear," as suggested by the Examiner. This claim clarification is not made for patentability purposes, and it is believed that the claim would satisfy the statutory requirements for patentability without the entry of such clarifications.

Claim 16

With respect to Claim 16, the Examiner has stated that there is insufficient antecedent basis for the limitation "said cable." Claim 16 has been clarified, without altering

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its scope, to recite "a cable." This clarification is not made for patentability purposes, and it is believed that the claim would satisfy the statutory requirements for patentability without the entry of such clarification.

Claims 17-18

With respect to Claims 17-18, the Examiner has stated that the claims are indefinite because "g" units are not units of force. Claim 17 recites a force "in the range of about 90g to about 140g," and Claim 18 recites a force "in the range of about 115g to about 130g." Although the claims are correct, the claims have been clarified, without altering their scope, to recite "gram force" rather than "g" as the unit of force. No new matter has been added with this amendment as it is merely a clarification that g as a unit of force refers to gram force. These claim clarifications are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such clarifications.

In addition, with respect to Claim 18, the Examiner has stated that there is insufficient antecedent basis for the limitation "said tissue site." Claim 18 has been clarified, without altering its scope, to recite "a tissue site." This clarification is not made for patentability purposes, and it is believed that the claim would satisfy the statutory requirements for patentability without the entry of such clarification.

Applicant respectfully requests the Examiner to withdraw the rejection of Claims 16-18 and 20 under 35 U.S.C. § 112, second paragraph.

Rejection Of Claim 1 Under 35 U.S.C. § 102

The Office Action rejected Claim 1 under 35 U.S.C. § 102 as being anticipated by U.S. patent no. 4,685,464, issued to Goldberger et al., (the Goldberger patent). The Examiner contends that the Goldberger patent shows an emitter that emits light of a first and second wavelength, a light sensitive detector which provides intensity signals resulting from detection of first and second wavelengths of light, a clip housing, and a plurality of tissue contacting surfaces. The Examiner also contends that the Goldberger patent shows a plurality of tissue contacting surfaces that include pliable or adhesive material that provide increased support for removably retaining the tissue contacting surfaces proximate to the tissue. The Applicants respectfully submit that Claim 1 as previously pending is patentably distinguished over the Goldberger patent the other

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cited references or any combination thereof. Although the Applicants respectfully disagree with the Examiner, the Applicants have amended Claim 1 and believe that this rejection of Claim 1 as well as Claims 2-3 and 13, which depend from Claim 1, is now moot. Accordingly, Applicants request that the Examiner reconsider and withdraw the rejection of Claims 1-3 and 13.

Rejection Of Claims 4-5, 7-12 and 17-21 Under 35 U.S.C. § 103

The Office Action rejected Claims 4 and 19 under 35 U.S.C. § 103 as being unpatentable over the Goldberger patent in view of U.S. patent no. 6,041,247, issued to Weckstrom, (the Weckstrom patent). The Examiner contends that the Weckstrom patent teaches a non-invasive optical measuring sensor and measuring method in which the window may be constructed of silicone. The Applicants respectfully submit that Claims 4 and 19 as previously pending are patentably distinguished over the Goldberger patent in combination with the Weckstrom patent or any other cited references. Although the Applicants respectfully disagree with the Examiner, the Applicants have amended Claims 4 and 19.

As amended Claim 4 recites, "An ear sensor . . . comprising: an emitter which emits light of at least first and second wavelengths; a light-sensitive detector . . . ; a clip housing including one or more windows . . . wherein the clip housing also houses the emitter and the detector . . . ; and a plurality of tissue contacting surfaces . . . , wherein the tissue contacting surfaces comprise silicone lenses and wherein said silicone lenses comprise a textured surface that increases a coefficient of friction between the silicone lenses and a tissue site." As amended Claim 19 recites, "An oximetry sensor comprising: a plurality of opposing members each housing one of an emitter and a detector, and each including one or more windows covered by one or more silicone lenses so that the lenses will contact a tissue site when the oximetry sensor is applied to the tissue site, wherein said plurality of opposing members are configured to removably position said silicone lenses against the suitable tissue site and wherein said silicone lenses comprise a textured surface configured to aid in reducing movement of the sensor."

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Accordingly, the Applicants believe that Claims 4 and 19 are patentably distinguished from the prior art. Claims 5, 7-12, and 17-18 which depend from Claim 4 and Claims 20-21 which depend from Claim 19 are believed to be patentable for the same reasons articulated above with respect to Claims 4 and 19, and because of the additional features recited therein. Accordingly, Applicants request that the Examiner reconsider and withdraw the rejection of Claims 4-5, 7-12, and 17-21.

Rejection Of Claims 14-16 Under 35 U.S.C. § 103

The Office Action rejected Claims 14-16 under 35 U.S.C. § 103 as being unpatentable over the Goldberger patent in view of U.S. published patent application no. 2005/0057925 identifying Mehler as inventor, (the Mehler patent). The Examiner concedes that the Goldberger patent does not teach the feature of "an attachment supplement" recited by Claim 14. However, the Examiner contends that it would have been obvious for one of skill in the art to modify the sensor taught by Goldberger to include the ear support as shown in connection with an earpiece light described in the Mehler patent. Applicants respectfully traverse this rejection on the basis that no motivation exists to combine the references together.

Section 2143.01 of the M.P.E.P. states that "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." Neither the Goldberger patent nor the Mehler patent includes any suggestion to combine the features of the inventions described therein. There is simply no suggestion in the Goldberger patent to modify the sensor to include an attachment supplement. The Mehler patent also includes no suggestion to modify the sensor of the Goldberger patent. The Mehler patent merely describes an earpiece light and in no way suggests using the ear support portion of that earpiece light with any other device.

Because the Examiner has failed to make the necessary showing that a person with the ordinary knowledge of those skilled in the art would have modified the sensor of the Goldberger patent to include a feature of the earpiece light described in the

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Mehler patent, the Examiner has not provided an adequate teaching, suggestion, or motivation to reject this claim based on the ordinary knowledge of those skilled in the art. Rather, it appears that the Examiner has impermissibly used hindsight derived from the teachings in the present application, and not the teachings of the prior art, to reject Claim 14. In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999) (holding the Board impermissibly used hindsight in determining obviousness); See also, M.P.E.P., Sect. 2145, part X.A.

The Applicant therefore respectfully submits that Claim 14 is patentably distinguished over the cited references and the Applicant respectfully requests allowance of Claim 14. Claims 15-16 which depend from Claim 14 are believed to be patentable for the same reasons articulated above with respect to Claims 14. Accordingly, Applicants request that the Examiner reconsider and withdraw the rejection of Claims 14-16.

Respectfully submitted,

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